

FROM BRIGHT & LORIG PC

(TUE) 07.06' 04 11:15/ST. 11:11/NO. 3560664729 P 17



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| APPLICATION NO. | FILING DATE | FIRST NAME OF INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 10/034,446 | 12/26/2001 | Rick K. Southern | D9426 | 1727 |

7590 04/15/2004

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R - C E I V E D D
APR 19 2004

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| EXAMINER |
| A. PHI DIBU TRAN |

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 3637 | |

DATE MAILED: 04/15/2004

BRIGHT & LORIG

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|-------------------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/034,446 | SOUTHERN ET AL. |
| | Examiner Phil D A | Art Unit 3637 <i>MJ</i> |

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION:

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 27 January 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3,5-7,10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3,5-7,10 and 12 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other. _____ |

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1. The Declaration under 37 CFR 1.132 filed 1/27/04 is sufficient to overcome the rejection of claims 1-3, 5-7, 10 and 12 based upon Greenway and Searer in view of Anderson et al.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5-7, 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenway (2088238) in view of Taylor et al (3740910) and Searer.

Greenway shows hardwood floor planks (page 2, col 2 lines 24-30) of at least about 3 feet (page 1 col 1 lines 26-29) onto a concrete surface and securing it with an adhesive, the floor having varying thickness at the grooves.

Greenway does not show the adhesive being water resistant, water impermeable adhesive, the boards being nailed to the concrete floor surface at right angles thereto through the boards and through the adhesive layer.

Searer shows a hardwood floor plank boards being nailed to the concrete floor surface at right angles thereto through the boards.

Taylor et al discloses a board (8) being secured to a substructure with nails (12) going through the boards and adhesives (14), the adhesive being water impermeable adhesive (col 1 lines 55-60), the nailing going through the board after the adhesive (14) has been applied to the boards (col 4 lines 54-57).

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It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Greenway to show the adhesive being water resistant, water impermeable adhesive as taught by Taylor et al, the boards being nailed to the concrete floor surface at right angles thereto through the boards as taught by Searer and through the adhesive layer because having the adhesive being water resistant water impermeable would prevent the adhesive from being damaged by water as taught by Taylor et al, and having nails going through floor boards to the concrete surface at right angles thereto through the boards and the adhesives would enable the adhesive to hold onto the boards while nailing the boards in positions and enable the adhesives to bond the boards in place upon drying without having to have a person holding the boards in place.

Greenway as modified shows all the claimed limitations. The claimed method steps for attaching solid hardwood floor planks to a concrete surface would have been the obvious method of attaching Greenway's structures to a concrete surface.

Response to Arguments

4. Applicant's arguments with respect to claims 1-3, 5-7, 10, 12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows boards secured to substructure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 703-306-9136. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Phi Dieu Tran A

4/13/04

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|-----------------------------------|--|-------------------------|--|------------------|
| Notice of References Cited | | Application/Control No. | Applicant(s)/Patent Under Reexamination SOUTHERN ET AL. | |
| | | 10/034,446 | Examiner | Art Unit 3637 |
| Phi D A | | | | Page 1 of 1 |

U.S. PATENT DOCUMENTS

| * | Document Number Country Code-Number-Kind Code | Date MM-YYYY | Name | Classification |
|---|--|-----------------|-----------------------|----------------|
| A | US-3,740,910 | 08-1973 | Taylor et al. | 52/315 |
| B | US-4,644,720 | 02-1987 | Schneider, Raymond H. | 52/392 |
| C | US-4,492,064 | 01-1985 | Bynoe, Robert J. | 52/309.8 |
| D | US- | | | |
| E | US- | | | |
| F | US- | | | |
| G | US- | | | |
| H | US- | | | |
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| M | US- | | | |

FOREIGN PATENT DOCUMENTS

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NON-PATENT DOCUMENTS

| * | Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages) |
|---|---|
| U | |
| V | |
| W | |
| X | |

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.